

Remarks

In the final Office Action dated July 8, 2009, new grounds of rejection are presented: claims 1-7 stand rejected under 35 U.S.C. § 103(a) over Kennedy (U.S. Patent No. 5,125,105) in view of Tanaka (U.S. Patent No. 5,870,666), Ichikawa (U.S. Patent No. 4,903,328) and Moers (U.S. Patent No. 6,957,053); claims 1-2 and 4-7 stand rejected under 35 U.S.C. § 112(1); and claim 3 stands rejected under 35 U.S.C. § 112(2). Applicant addresses these rejections in the following discussion which does not acquiesce in any regard to averments in this Office Action (unless Applicant expressly indicates otherwise).

Applicant respectfully traverses the § 103(a) rejection because the cited combination of references lacks correspondence to the claimed invention. The Examiner fails to address the claimed invention “as a whole” (§ 103(a)) as required. Instead, the Examiner improperly relies upon disparate portions of four different references in asserting correspondence to individual aspects of the claimed invention while failing to address such aspects of the claimed invention in their entirety. For example, none of the asserted references teaches the claimed invention “as a whole” (§ 103(a)) including aspects regarding, *e.g.*, checking, a predetermined number of times, whether a FM signal has both a signal strength greater than a FM threshold and is in an automatic frequency control (AFC) window and then incrementing a count. Because none of the references teaches these aspects, no reasonable combination of these references can provide correspondence to the claimed invention. As such, the § 103 rejection fails.

More specifically, Applicant recognized that by checking whether the FM signal meets both of these criteria multiple times before storing the frequency of the FM signal, the capture of random noise signals can be significantly mitigated. *See, e.g.*, paragraphs 0004, 0005 and 0007-0009 of Applicant’s specification. Applicant submits that none of the cited references teach or suggest such aspects and thus the cited combination does not correspond to the claimed invention.

Turning now to the cited references, the Examiner acknowledges that the ‘105 and ‘053 references do not teach checking whether the FM signal meets both the signal strength and AFC window criteria multiple times and incrementing the count each time both criteria are met, as in the claimed invention. The ‘666 and ‘328 references, however, also fail to teach such aspects. For example, the ‘666 reference simply teaches

checking the RSSI (received signal strength indicator) of a received signal M times (*see, e.g.,* Col. 3:64 to Col. 4:8), and the '328 reference simply teaches checking multiple times whether a received signal is in a desired frequency range (*see, e.g.,* Col. 1:48 to Col. 2:19). As such, none of the cited references teach a testing process that involves checking that the FM signal has the desired signal strength, then checking that the FM signal is in the AFC window if the signal strength test is met, then incrementing the count if the AFC window test is met, and then repeating the testing steps a predetermined number of times, as in the claimed invention. As none of the cited references teach such aspects, the Examiner appears to be improperly combining the cited references in the manner taught by Applicant's disclosure in an improper hindsight reconstruction of the claimed invention. *See, e.g.,* M.P.E.P. § 2142.

Moreover, the Examiner fails to provide adequate motivation for combining the '105 and '666 references. In this instance, the Examiner's proposed combination does not involve simply combining teachings in which the cited references are not modified in their operation as was addressed in *KSR*. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). Instead, the '105 and '666 references are directed to receiving and processing different types of signals (analog versus digital) and, as such, the relied upon teaching of the '666 reference cannot simply be applied to the '105 reference as asserted by the Examiner. Thus, the proposed combination would involve modifying the teaching of the '666 reference in some undisclosed manner that has not been addressed by the Examiner. Accordingly, the Examiner's assertion of some vague "articulated reasoning" in support of the modification (*e.g.,* "for better assurance") is insufficient. *KSR* and M.P.E.P. § 2141 make it clear that such assertions are inapplicable where the operation of one of the references is modified. For example, according to M.P.E.P. § 2141, Applicant can rebut such assertions of obviousness simply by showing that "the elements in combination do not merely perform the function that each element performs separately." This is also consistent with various parts of *KSR*, which repeatedly refer to combined teachings in which the cited references are not modified in their operation. As such, in the context of *KSR*, the asserted combination "as a whole" is entirely unpredictable based on the asserted teachings of the '105 and '666 references.

In view of the above, the § 103(a) rejection is improper and Applicant requests that it be withdrawn.

Applicant respectfully traverses the § 112(1) rejection because the claims are fully supported by Applicant's disclosure. Applicant submits that support for aspects of claim 1 directed to scanning the receiver frequency band until a FM signal is received that has a signal strength greater than a FM threshold and that is in an automatic frequency control (AFC) window associated with a valid FM station can be found, for example in paragraph 0006 of Applicant's specification. Specifically, paragraph 0006 discusses applying two conditions (signal strength and AFC status) to decide whether a received signal is a valid FM station. Applicant notes that support for the above discussed aspects can also be found in the first iteration shown and discussed by Applicant's Figure and paragraph 0013. Accordingly, the § 112(1) rejection is improper and Applicant requests that it be withdrawn.

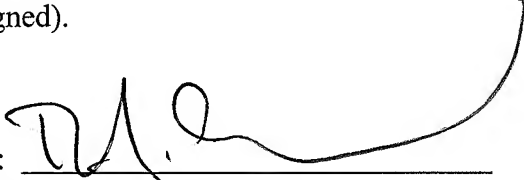
Applicant respectfully traverses the § 112(2) rejection of claim 3 because the Examiner improperly equates breadth with indefiniteness. *See, e.g.*, M.P.E.P. § 2173.04 ("Breadth of a claim is not to be equated with indefiniteness."). In this instance, the Examiner asserts that "a number of times" should be limited to 2 or more. Thus, the Examiner appears to be improperly attempting to argue the scope of the claims under the guise of indefiniteness. Accordingly, the § 112(2) rejection of claim 3 is improper and Applicant requests that it be withdrawn. Applicant further notes that the rejection should have been in the form of a non-final Office Action because the Examiner has improperly presented new grounds of rejection (*e.g.*, the § 112(2) rejection of claim 3) for the first time as a final rejection because aspects of claim 3 directed to counting means for registering a number of times were present in claim 3 prior to the amendment filed on April 7, 2009. *See, e.g.*, M.P.E.P. § 706.07(a).

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062 (or the undersigned).

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